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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Warrantynet Corp.

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Serial No. 76/069,748

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James C. Wray, Esq. for Warrantynet Corp.

Boris Umanski, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

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Before Cissel, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 14, 2000, applicant, a Massachusetts Corporation, filed the above-referenced application to register the mark "WARRANTYNET" on the Principal Register for the following goods and services:

> on-line computer software for the registration, purchase, sale, data mining, tracking, processing and management of warranties and warranty-related information and services for others for use on local, wide area, global computer networks, namely extranets, intranet, and the worldwide web;

computer communications software to automate data warehousing of the registration, purchase, sale, tracking, data mining, processing and management of warranties and warranty-related information for others for use on local, wide area and global computer networks, namely extranets, intranet, and the worldwide web;

computer software for web application database development, management and maintenance in the field of warranties; computer software for optimizing the business process and supply chain activities with others in the field of warranties and warranty-related services; and computer software to facilitate warranty transactions via web-based appliances, all in International Class 9; and

computer consultancy services in the area of computer software, namely design, development and installation of computer software for warranties, interactive databases, namely on-line facilities for real time interaction with other computer users, computer bulletin and message boards for warranties; technical support services; electronic transmission of data via local, wide area and global computer networks, namely extranets, intranet and the worldwide web in International Class 42.

The application stated that applicant "has been by itself or through a licensee or by a predecessor in title, Business Interactive Corp., and through a licensee or by itself and through a licensee since using the above-referenced mark in international commerce between the United States of America and Canada or in interstate commerce" in connection with the goods and services listed above. No dates of use or specimens of use of the mark were provided, however.

The original Examining Attorney[1] refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the term sought to be registered is merely descriptive in connection with warranty tracking network software and the electronic transmission of warranty data over networks. He also held that both the identification of goods and the recitation of services were unacceptable, and suggested possible acceptable identifications and recitations in International Classes 9, 38 and 42. In addition, he advised applicant that the basis for filing the application was not clear, in that applicant appeared to have filed the application based on actual use of the mark in commerce, but no dates of use or specimens of use were provided.

Responsive to the first Office Action, applicant amended the application to identify the goods and services as follows:

> computer e-commerce software to allow users to perform electronic business transactions via a global computer network in the field of warranties and warranty-related information; computer software for the browsing, comparison, registration, purchase, sale, data mining, tracking, processing and management of warranties and warranty-related information and services for use on local, wide area, global computer networks, in International Class 9;

[1] After the first Office Action, this application was reassigned to the Examining Attorney designated above.

> electronic transmission of messages and data; providing online chat rooms for transmission of messages among computer users concerning warranties, providing online electronic bulletin boards for transmission of messages among computer users concerning warranties, in International Class 38; and
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> computer consultation services in the area of design, development and installation of electronic commerce applications, namely, shopping cart applications, electronic marketplaces, purchasing agents, and functionalities for the registration, browsing, comparison, purchase, retail sale, processing and management of warranties and warranty-related information and services to be used in association with online stores and interactive databases; technical support services namely, troubleshooting of computer hardware and software problems via telephone, e-mail and in person, in International Class 42.

The appropriate fee was submitted to cover the additional class of services.

In addition to making these amendments, applicant argued that the refusal based on descriptiveness was not well taken, and advised the Examining Attorney that the basis for filing the application was Section 44 of the Act, in view of an application which applicant had previously filed in Canada. Applicant listed the Serial Number as 1,047,906, but did not provide either a copy or a filing date for its Canadian application.

The Examining Attorney accepted the amendments to the identification of goods and the recitation of services, but maintained and made final the refusal to register under Section 2(e)(1) of the Act based on mere descriptiveness.

In support of this refusal to register, he made of record a copy of an entry from an acronym dictionary which shows that "NET" is an acronym for both "network" and "Internet." Also made of record with the second Office Action were copies of dictionary definitions of "net" as a "computer network"; of "network" as "a group or system of electronic components and connecting circuitry designed to function in a specific manner" and as "a system of computers interconnected by telephone wires or other means in order to share information." This definition noted further that a "network" is also called "net."

The Examining Attorney noted that applicant had claimed priority under Section 44(d) of the Act and advised applicant that because applicant did not assert this basis in the original application or within six months after filing it, applicant could not claim this basis for filing this application. The Examining Attorney again advised applicant to assert a basis for filing, and suggested that applicant could assert its intention to use the mark in commerce as a proper basis. This requirement for a properly asserted filing basis was maintained and made final.

Applicant responded to the second Office Action with additional argument against the refusal based on Section

2(e)(1) of the Act. Additionally, applicant stated that it had possessed a bona fide intention to use the mark in commerce in connection with the specified goods and services since the filing date of the application. A supplemental response from applicant included a declaration to this effect by applicant corporation's "principal." The declaration stated that "[t]he applicant has had a bona fide intention to use the mark in commerce or in connection with the goods and services listed in the application since the filing date of the application."

Applicant timely filed a Notice of Appeal. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant's supplemental response.

The Examining Attorney was not persuaded to withdraw the refusal to register or the requirement for applicant to state a proper basis for filing the application. Attached to the Examining Attorney's response were additional exhibits. Copies of two pages from what appears to be applicant's web site, WarrantyNet.com, were submitted. The material contains several statements. Applicant "provides web-based warranty management solutions (composed of software and services) to individuals, corporate buyers, and the Warranty Supply Chain™, e.g., warranty providers,

manufacturers, retailers, service centers and insurers." Applicant "enables manufacturers, retailers and other warranty providers to process online and off-line warranty information for central electronic storage and processing," as well as helps retailers "to sell extended warranties and provide better customer service." Applicant "helps warranty providers to transform warranty data into business intelligence that may be used to market more effectively, provide better customer service, reduce fraud, track repair trends, and increase service revenue from extended warranties…."

Also included with this Office Action were copies of a number of third-party trademark registrations on the Supplemental Register for marks which combine generic or descriptive terminology with the terms "NET" or ".NET." Registration on the Supplemental Register indicates that these marks are merely descriptive of the services with which they are used. Examples of these marks include Reg. No. 2,633,705 for "REPORT.NET" for "tracking and monitoring insurance compliance and information and providing information on insurance tracking and monitoring"; Reg. No. 2,404,945 for "EXPENSENET" for "computer software for use in reporting, auditing, payment and archiving of employer business expenses"; and Reg. No. 2,606,195 for "HRNET" for

"information technology consulting services for businesses relating to automation of human resources functions."

Action on the appeal was resumed by the Board, and both applicant and the Examining Attorney submitted appeal briefs. The applicant also filed a reply brief, but did not request an oral hearing.

There are two issues for our resolution in this appeal: (1) whether "WARRANTYNET" is merely descriptive of the goods and services specified in the application, as amended, within the meaning of Section 2(e)(1) of the Lanham Act; and (2) whether applicant has asserted a valid basis for filing the application.

Based on careful consideration of the written record in this application and the arguments presented by both applicant and the Examining Attorney, we hold that the refusal to register is well taken and that applicant has failed to assert a valid basis for filing the application.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), is well settled. A mark is unregistrable under this section if it describes a significant characteristic, function, feature, purpose or use of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed &

Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); and In re MetPath Inc., 223 USPQ 88 (TTAB 1984). This determination must be made in relation to the identified goods or services, rather than in the abstract. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The question is whether a person who is familiar with the goods or services will understand the mark to convey significant information about them. In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990). The mark does not have to describe all of the purposes, functions, characteristics or features of the goods or services in order to be considered merely descriptive of them within the meaning of the Trademark Act. It is sufficient if the mark describes one attribute or feature of them. In re MBAssociates, 180 USPQ 338 (TTAB 1973). A mark which combines two or more descriptive terms may qualify for registration if the combination creates a mark that is not descriptive. In re Putnam Publishing Co., 39 USPQ2d 2021 (TTAB 1996). Unless the combination results in a mark which has a separable, nondescriptive meaning, however, the mark remains unregistrable under Section 2(e)(1).

In the instant case, applicant's mark, "WARRANTYNET," is merely descriptive of the goods and services set forth

in the application because it describes a feature or characteristic of them, namely that applicant's software products and services all relate to warranties and are provided by means of, or are used in conjunction with, various networks, such as the Internet, LANs (local area networks) and WANs (wide area networks). The above-quoted passage from applicant's website makes it clear that applicant provides warranty management solutions by means of software and services through computer networks. Applicant promotes itself as an expert in designing, implementing and operating "web-based warranty-related services." Accordingly, the mark applicant seeks to register, which is a combination of the descriptive terms "WARRANTY" and "NET," is merely descriptive within the meaning of the Act because it conveys the fact that applicant provides warranty management solutions through its network and Internet related goods and services. The goods in Class 9 are software which facilitates warranty transactions by means of networks; the services in Class 38 are essentially providing a network for transmission of messages regarding warranties; and the services in Class 42 involve consulting with regard to the design of computer networks which feature processing and management of warranties and warranty-related information and services to

be used in association with interactive databases, or networks.

Applicant argues that the composite of the terms is incongruous, ambiguous and unclear, such that in order to glean the descriptive meaning from the term, consumers would need to engage in complex thought processes or multi-stage reasoning. This argument is unpersuasive, however. This combination of two descriptive terms does not create any incongruity. No imagination is required to understand from the mark the nature of the goods and services specified in the application. See In re Associated Theater Clubs Co., 9 USPQ2d 1660 (TTAB 1988). Combining the word "WARRANTY" with the term "NET" would not cause consumers to fail to recognize the descriptive significance of each term.

Applicant argues that if its mark were merely descriptive, the Examining Attorney should have been able to produce evidence that others in the field use it to describe their own goods or services. Applicant asserts that because no such evidence was made of record, and because the proposed mark, in its composite form, does not exist in the English language, the mark cannot be held to be merely descriptive within the meaning of the Act. These arguments are not persuasive. That applicant may be the

first, or even the only, user of this descriptive terminology does not justify registration. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983). The fact that a term is not found in dictionaries is not controlling on the issue of mere descriptiveness. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

We thus turn to the second ground for refusing registration in the case at hand. The application, as originally filed, was unclear as to the basis for filing it. Applicant was advised of this problem. Applicant's subsequent claim of priority under Section 44(d) of the Act was improper because such a claim must be asserted within six months from the date when the foreign application was filed. Section 44(d)(1) of the Act and Trademark Rule 2.34(a)(4)(i). As noted above, applicant was advised of this problem as well, and it provided a declaration relating to its intent to use the mark in commerce. That declaration reads as follows: "The applicant has had a bona fide intention to use the mark in commerce or in connection with the goods and services listed in the application since the filing date of the application." (Emphasis added). The Examining Attorney made it clear that this declaration was unacceptable, but that if any substitute declaration

adding the word “on” before the word “or” were provided, such a declaration would constitute an acceptable basis for filing the application under Section 1(b).

Not only did applicant fail to correct this problem, applicant did not even address it.

Because the Trademark Act and the Trademark Rules of Practice require an applicant to include a statement of what the basis is for filing the application and applicant has failed to do so, the Examining Attorney’s requirement for such a statement is entirely appropriate.

In summary, both refusals to register are proper. The mark is merely descriptive of the goods and services set forth in the application, as amended, because it identifies significant characteristics or features of them. Additionally, applicant has not provided a proper basis for filing the application.

DECISION: Both refusals to register are affirmed as to each of the classes of goods and services.